

Office Action Summary

Application No.

10/690,404

Applicant(s)

MORIYAMA, HIROKI

Examiner

MATTHEW J. KASZTEJNA

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 1/23/08
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice of Amendment

In response to the amendment filed on November 19, 2007, amended claims 1 and 17 and new claim 18 are acknowledged. The current rejections of claims 1-17 are *withdrawn*. The following new grounds of rejection are set forth:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,690,175 to Ouchi et al. in view of U.S. Patent No. 5,916,147 to Boury.

In regards to claims 1-4 and 17, Ouchi et al. a flexible tube for use in an endoscope comprising: an insertion unit having a soft portion; a small-diameter portion 3c which is included in the soft portion and whose outer diameter is substantially the same over the whole length thereof; a large-diameter portion 3f which is formed on the operator side of the soft portion opposite the small-diameter portion and whose outer diameter is larger than the outer diameter of the small-diameter portion; and a tapered portion 3d-e linking the small-diameter portion and the large-diameter portion, and a thickness of a sheathing resin is varied in order to form the small-diameter portion, the large-diameter portion and the tapered portion (see Fig. 5 and Col. 7, Lines 9-35).

Ouchi et al. teach of a flexible tube relating generally to flexible tubes for endoscopic devices having improved flexibility, torsional rigidity and resistance to compression for facilitating insertion of the tube into the body cavity but are silent with respect to the insertion portion having an articulating section at the distal end of the endoscope and a control section disposed at the proximal end of the insertion unit for controlling articulation of the articulating section. Boury teaches of an analogous apparatus comprising a catheter which can be manipulated by a physician even after the catheter is placed into the patient's body. The catheter includes an elongate tubular member which has a proximal end, a distal end, a remotely manipulable length, and a wall defining a lumen. The catheter also includes first and second wires slidably retained by the wall and extending proximally beyond the proximal end of the tubular member. The first wire is attached adjacent a distal end thereof to the wall at a first node located along the manipulable length. The second wire is attached adjacent a distal end thereof to the wall at a second node located along the manipulable length, with the second node being located distally of the first node along the manipulable length of the tubular member (see Figs. 1-3 and Col. 2, Line 53 – Col. 3, Line 25). Boury demonstrates that it is well known within the art to provide endoscopic devices with control means to facilitate insertion of the flexible tube within the body. Thus, It would have been obvious to one skilled in the art at the time the invention was made to provide the apparatus of Ouchi et al. with an articulating section and a control section to control the insertion section, thus allowing a physician to shape a length of the tube and to permit it to be more readily positioned within a body channel of the patient as taught by Boury and is

well known within the art. Furthermore, Boury teaches that the overall length of the insertion tube may be varied as necessary, from 50-150 cm (see Col. 4, Lines 6-20). Thus the tapered portion would be located forward an endoscope portion located 45cm from the distal end.

In regards to claim 18, Ouchi et al. a flexible tube for use in an endoscope, wherein the thickness of the sheathing resin is varied in order to form the small-diameter portion, the large-diameter portion, and the tapered portion; and the sheathing resin has an inner diameter formed to be constant over the small-diameter portion, the large-diameter portion, and the tapered portion (see Fig. 5 and Col. 7, Lines 9-35).

Claims 5-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,690,175 to Ouchi et al. in view of U.S. Patent No. 5,916,147 to Boury in further view of U.S. Patent No. 5,084,022 to Claude.

In regards to claims 5-16, Ouchi et al. and Boury disclose an apparatus having a articulating section, a control section and large and small diameter portions connected via a tapered portion but are silent with respect to indices indicating distances from the distal end are inscribed on the soft portion. Claude teaches of an analogous medical apparatus provided with spaced indicia to indicate the distance the instrument is extended into a vascular vessel, catheter or other instrument (see Figs. 1-3). Furthermore the indices are capable of being formed on the instrument in any desired location considered to be helpful to the operator and the desired procedure. It would have been obvious to one skilled in the art at the time the invention was made to include

indices on the apparatus of Ouchi et al. and Boury in order to facilitate the determination of the distance an instrument extends into a cavity as taught by Claude.

Response to Arguments

Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. KASZTEJNA whose telephone number is (571)272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. J. K./
Examiner, Art Unit 3739

1/30/08

Application Number**Application/Control No.**

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**Applicant(s)/Patent under
Reexamination**

MORIYAMA, HIROKI

Examiner

MATTHEW J. KASZTEJNA

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